

REMARKS

The Office Action dated March 9, 2006 has been received and carefully considered. Claims 1-26 are currently pending. Claims 11-26 were previously withdrawn from consideration as being directed to non-elected species in the Response to Restriction Requirement filed on August 19, 2003.

I. CLAIM AMENDMENTS

Applicant has made minor amendments to the claims to correct minor informalities not affecting the scope of the claims. The amendments are not narrowing amendments, nor are they made for reasons of patentability, as considered under the *Festo* decision of the Federal Circuit.

Claims 1 and 10 (both independent) are amended so that the first introduction of a claim element in the body of the claim is made using the article "a" or "an" instead of "said." Claim 6 has been amended to correct typographical errors.

No new matter has been added. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

II. OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-10 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the AFS document entitled Positive Pay ("Positive Pay") in view of U.S. Patent Publication No. 200110037315 to Saliba et al. ("Saliba"). The rejections for these claims are hereby respectfully traversed.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings as urged by the Examiner in his obviousness rejection. Second, there must be a reasonable expectation of success. Finally, the proffered combination of prior art references (or references when modified) must have all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488,20 USPQ2d 1438 (Fed. Cir. 1991).

As stated in MPEP § 2143.01, the first requirement of the *prima facie* case provides that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347,21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); *In re Edward S. Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) ("The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. . . . The PTO may not disregard claim limitations . . .") [underscore added] [citing *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983)].

A. Positive Pay fails to teach or suggest all of the claim limitations

Regarding independent claims 1 and 10, the Examiner asserts, among other things, that Positive Pay discloses a method of notifying an exception client associated with a payor financial institution of an exception item, said method comprising: receiving a presentment check file, said presentment check file including presentment information related to checks presented to said payor financial institution for payment; receiving a payor check file from said exception client, said payor check file including check information relating to checks written by said exception client; comparing said presentment check file with said payor check file thereby producing at least one exception item. *See* Office Action at p. 2-3, citing Positive Pay at p. 1-2.

Applicants respectfully traverse the Examiner's expansive reading of Positive Pay. In fact, Positive Pay does not teach or suggest many of the recited features and functionalities of independent claims 1 and 10, including but not limited to the specific recitations set forth above. For example, Positive Pay does not disclose any feature or functionality of claim 1 comprising the steps of receiving and comparing a single presentment check file with a payor check file and sending an exception item notification via e-mail, as recited in claim 1. Additionally, Positive Pay does not disclose a sending an exception item via e-mail and including a hyperlink to the address of a Web file of an image relating to the exception item, as recited in claim 10. Rather, Positive Pay – as evidenced by the excerpt relied upon by the Examiner – merely discloses:

Each day the Positive Payment operator validates the existing issues against the captured Inclearing and Proof of Deposit runs...Each customer subscribing to positive payment is identified and those items are validated against the issue records received. Amount errors, duplicate errors, and unfound issued item errors are identified by the system and presented to the operator...Reports with images and error explanations of the suspect items can be faxed directly to the customer for verification prior to posting of these items.

See Positive Pay at p. 1-2.

Specifically, Positive Pay discloses capturing a "Inclearing and Proof Deposit runs" and "issue records" (plural), which are distinguished from a single presentment check file that contains all the presentment information related to checks presented to said payor financial institution for payment, as recited in claims 1 and 10. Furthermore, Positive Pay merely discloses notifying customers of errors and suspect items by "faxes." This is distinguished from e-mail notification, as recited by claims 1 and 10. Additionally, Positive pay makes no mention of any type of Web file or related hyperlink directed to images of the exception item. Thus, Applicants respectfully submit that Positive Pay does not teach or suggest each and every specific recitation of claims 1 and 10. Accordingly, for at least this reason, Applicants respectfully request that the obviousness rejection of claims 1 and 10 be withdrawn.

B. Saliba fails to make up for deficiencies of Positive Pay

Applicants respectfully submit that Saliba fails to make up for the deficiencies of the primary reference, Positive Pay, as discussed above. Saliba is relied upon by the Examiner for allegedly teaching sending an e-mail notifying a client of said item (referring to bill data), generating a Web file, generating an address for said Web file, sending an e-mail including a hyperlink to the address, and sending an image of a check. *See* Office Action at p. 3-4, citing Saliba at Figures 10 and 12.

Applicants respectfully submit, however, that Saliba does not teach or suggest many of the recited features and functionalities of independent claims 1 and 10, including but not limited to the specific recitations set forth above. For example, Applicant submits that also Saliba fails to teach or suggest the steps of receiving and comparing a single presentment check file as recited in the claims. Rather, Saliba does not disclose or even mention anything to do with check exceptions. Saliba – as acknowledged by the Examiner – merely discloses receiving "bill data." *See* Office Action at p. 3. Furthermore, even assuming for the sake of argument that Saliba discloses a single presentment check file (which it clearly does not disclose), Saliba does not disclose sending an e-mail notification for the at least one check exception item, as recited in the claims. Instead, Saliba teaches generating email messages to securely transfer information, namely "bill data." *See* Saliba at [0012]. For at least the reasons discussed above, Saliba fails to teach all the claimed limitations and fails to remedy the deficiencies of Positive Pay. Therefore, in view of the foregoing, Applicants respectfully request that the obviousness rejection of claims 1 and 10 be withdrawn.

C. Lack of motivation to combine

Further, Applicant respectfully submit that the Examiner does not present a proper motivation to combine the references to achieve the claimed system and method, and thus has failed to set forth a *prima facie* case of obviousness. In particular, Applicant respectfully submits that the allegation that one of ordinary skill in the art would have modified Positive Pay by the teaching of Saliba because Positive Pay "can benefit from the process described in [Saliba]...[and] to further automate the batch bank issuance process...to solve the same problem, in the same industry" is not persuasive. *See* Office Action at p. 4.

First, Applicant respectfully submits that the Examiner improperly *assumes* the combination recited in the claim would be desired. For example, the Office Action asserts that the "examiner believes that it would have been obvious for one skilled in the art to have looked to the secondary reference as a means for further automating the positive pay system" (emphasis added). See Office Action at p. 4. The PTO has the burden to establish that the prior art taken as a whole suggests the desire or advantage. Here, the Examiner himself boldly assumes (not the reference as whole) that it would have been obvious to combine by asserting that automation is "well known." However, the Examiner fails to explain why the art would suggest an e-mail notification specifically for a check exception. Thus, Applicant submits that the Examiner's assumption is improper.

Second, Applicant submits that the Examiner's assertion of motivation is lacking in *evidence*. Instead, the Examiner improperly relies on his own hindsight conjecture that the step of e-mailing is "well known" and "obvious." For example, the motivation cited by the Examiner to combine the references is nowhere to be found in either the Positive Pay or Saliba references. Second, even assuming that the motivation is applicable, Positive Pay makes no suggestion that it would benefit from the teachings of Saliba, specifically the use of an e-mail notification. For example, Positive Pay is concerned with fraud detection, specifically the verification of checks, whereas Saliba is primarily concerned with secure transmission of information such as bill data and financial account information. Therefore, the person of ordinary skill would not likely be motivated to combine teachings from these disparate references to arrive at Applicant's invention.

As a result, the Examiner's statement that Positive Pay "can benefit" from Saliba is wholly unsupported. In short, the assertion that a primary reference purportedly "can benefit" from a secondary reference does not constitute specific motivation or suggestion for the combination. The inquiry is not whether, in *post hoc* fashion one reference "might benefit" from another—rather, the inquiry is whether the prior art provides specific motivation to select the second reference and combine it with the first. Therefore, Applicants respectfully submit that the combination of Positive Pay and Saliba would not have been obvious to one of ordinary skill in the art at the time of the invention and that the Examiner's conclusion is clearly based on

improper hindsight reasoning. Thus, the Examiner has failed to set forth a *prima facie* case of obviousness. For at least the reasons discussed above, the obviousness rejection is improper and should be withdrawn.

D. Dependent claims

Claims 2-9 are dependent upon independent claim 1. Thus, since independent claims 1 should be allowable for the reasons discussed above, claims 2-9 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 2 recites *generating a Web file*, said Web file including exception information relating to said exception item; and *generating an address for said Web file; wherein said e-mail includes said address*. Applicant respectfully submits that none of the cited references, alone or in combination, teach or suggest the device of claim 1 having the step of generating a Web file, said Web file including exception information relating to said exception item; and generating an address for said Web file; wherein said e-mail includes said address. Also, claim 4 recites that the step of *performing a scrubbing process* to determine whether said exception item is a true exception item. Applicant respectfully submits that none of the cited references, alone or in combination, teach or suggest the device of claim 1 having the step of the step of performing a scrubbing process to determine whether said exception item is a true exception item.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-10 be withdrawn.

III. CONCLUSION

It is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for the extension of time under 37 C.F.R. § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-1700, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Dated: August 29, 2002

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